UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,435	06/26/2002	Frank Uhlik	15353	9151

7590 04/06/2004

EXAMINER
TRAN LIEN, THUY

ART UNIT	PAPER NUMBER
1761	

Frank S DiGiglio
Scully Scott Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/088,435	UHLIK, FRANK	
	Examiner	Art Unit	
	Lien T Tran	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claims 63,65 provide for the use of ingredients for preparation of a mix, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 63, 65 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 17-25,29-31,36-47,54-59,63-67 rejected under 35 U.S.C. 102(b) as being anticipated by Trop et al.

Trop et al disclose a process for preparing mixes for preparation of products in a substantial absence of wheat flour. The mixes comprise from 50-80% starch, about 8-20% of a whipping agent and .5-10% of a binding agent. The starch is selected from the group consisting of corn flour, rice flour, soybean flour, potato flour, tapioca flour,

cassava flour, sweet potato flour and yams. The whipping agent is selected from the group consisting of margarine, butter, cream and vegetable lipid. The binding agent is gelatin. The products obtained from the mix have desired distribution and abundance of gas cells. The mixture is blended with 200 ml of water and is heated at temperature ranging from 170-175 degree C. Example 9 shows the use of tapioca starch; the other examples show a mixture of starches is used. (see col. 2, col. 3 lines 40-68 and the examples)

The reference discloses all the limitations of the above cited claims. The mix is used to prepare products that do not contain gluten materials. Thus, the preparation of the mix is the preparation of a gluten substitute. The mix after heating is an aerated mass because it contains gas cells and it is expanded. The percent of water is calculated to be 36% which is within the range. Since the amounts of starch and protein fall within the ranges claimed, it is inherent the ratio of protein to starch also fall within the ratios claimed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12-16,26-28,32,33-44,48-53,60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trop et al.

The teaching of Trop et al is described above. Trop et al do not disclose the amount of fat in the ranges claimed in claims 11-12, 48-50, the fat to starch and fat to protein ratios as claimed, the fat and protein obtained from the same source, the amount of water claimed in claim 32, the temperature for heating as claimed, heating by extrusion and microwaving and drying the aerated mass.

Trop et al teach to add a source of fat to function as whipping agent; while they disclose the amount to be from 8-20%, there is no criticality disclosed for this amount. It would have been obvious to one skilled in the art to use smaller amount of fat if one desires to decrease the fat content of the products. It is obvious the ratios of protein to fat and starch to fat will change when smaller amount of fat is used. It would have been obvious to one to vary these ratios depending on the fat content, the taste, texture and flavor desired. As to the heating temperature, it would have been obvious to use higher temperature for shorter period of time or vice versa. The heating temperature also can vary depending on the degree of doneness desired and the type of product made. It would have been within the skill of one in the art to determine the appropriate temperature. It would also have been obvious to heat by using a microwave oven or an extrusion because both forms of heating are notoriously well known in the art. The selection of which depends on the availability of the equipment. Microwave is

commonly used in a household setting while an extrusion is more commonly use in an industrial setting. It would have been obvious to cool the product after heating it and such cooling will dry the product. Trop et al disclose egg powder and soybean flour can be used; when such products are included, it will provide a fat and protein source. It would have been obvious for one to add such ingredients depending on the nutrition, flavor, texture wanted in the products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien T Tran whose telephone number is 571-272-1408. The examiner can normally be reached on Tuesday, Wednesday and Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 2, 2004

LIEN TRAN
PRIMARY EXAMINER
Group 1702